

REMARKS

Status of the claims

Claims 9, 11, 18, 21, 22, 27 and 28 are pending in the application, with claims 1-8, 10, 12-17, and 23-26 being cancelled. Claims 9, 11, 18, 21, 22 and 27 are amended herein. Claim 28 is newly added. Support for claim 28 may be found in pending claim 11. No new matter has been added by way of these amendments or new claim. As such, entry and consideration thereof are respectfully requested.

Objections to the claims

Claim 23 has been objected to as being improperly dependent. Claim 23 has been cancelled, thus obviating this rejection.

Claim 18 has been objected to for recitation of "the ability to block of the compounds to block the chloride channel C1C-7". Claim 18 has been amended as suggested by the Examiner and "of the compounds to block" has been deleted from the claim.

Claims 9, 11, 18, 21-23 and 27 have been objected to for recitation of "CIC" whereas the specification recites "CIC". Applicants respectfully note that the proper nomenclature is "CIC", which stands for "chloride" (i.e. "Cl") "channel" (i.e. "C"). An error was unfortunately introduced into the nomenclature in the specification with the substitute specification submitted January 21, 2004. The undersigned is preparing another substitute specification correcting the nomenclature for the channels back to "CIC", which will be submitted upon completion. Thus the claims as pending are correct and withdrawal of the objection is respectfully requested.

Priority Claim under 35 U.S.C. §119(e)

The Examiner notes the omission in the specification of a reference to the priority provisional application No. 60/265,874. The Examiner further notes that this error was additionally introduced when the substitute specification was filed, at which time the reference to the provisional application, which had been previously made, was erroneously omitted. The substitute specification under preparation will include the necessary reference to the provisional priority application.

Rejections under 35 U.S.C. §112, 2nd paragraph

Claims 9, 11 and 23 have been rejected under 35 U.S.C. §112, 2nd paragraph as being unclear. Claim 9 has been amended to address this issue and claim 23 has been cancelled. Withdrawal of the rejection is respectfully requested.

Rejections under 35 U.S.C. §112, 1st paragraph

Claims 9, 11, 18, 21-23 and 27 have been rejected under 35 U.S.C. §112, 1st paragraph for lack of enablement with regard to screening compounds for activity in the prevention of an osteoclast related bone disease or activity in the treatment, alleviation or prevention of osteopetrosis. Claim 9 has been amended to recite, "A method for screening a chemical compound for activity in blocking the chloride channel CIC-7..." Thus, the recitation of "the treatment, prevention or alleviation of an osteoclast related bone disease in a subject," has been deleted from claim 9. Applicants note that the "intended use" of a compound as recited in claim 9 is generally not considered as a feature of the claimed invention in determining patentability. As such, this language has been deleted as being extraneous. The rejection for lack of enablement is further believed to be overcome with the amendment.

In addition, claim 27 has been amended to delete the recitation of "prevention" and "osteopetrosis".

Withdrawal of the rejection is therefore respectfully requested.

Rejection under 35 U.S.C. §102(e)

Claims 9, 18 and 21-23 have been rejected under 35 U.S.C. §102(e) as being anticipated by Maher et al. US 6,686,193. Maher et al. is asserted to teach screening for compounds that inhibit the CIC-7 chloride channel.

Maher et al. discloses very generally drawn to methods of screening compounds that target various ion channels. The only disclosure in the reference regarding the CIC-7 channel is in Table 3, which indicates that the CIC-7 channel is a chloride channel that is ubiquitously expressed.

The instant invention has been further defined in claim 9 to be specifically drawn to a method that requires “providing a test cell comprising one or more CIC-7 chloride channel[s] **expressed in osteoclasts and** of the CIC family”. Claim 18 has been similarly amended. There is no disclosure or suggestion in Maher et al. of a screening method that specifically utilizes the CIC-7 channel from osteoclasts. Indeed, there is no disclosure or suggestion in Maher et al. that osteoclasts even express a CIC-7 chloride channel. As such, the instant invention is neither anticipated by nor obvious over Maher et al. and withdrawal of the rejection is respectfully requested.

Revocation of Power of Attorney and new Power of Attorney

Submitted concurrently herewith is a Revocation of Power Attorney, which revokes the power of attorney given to the current attorneys of record, Edwards & Angell, LLP and concurrently appoints the offices of undersigned as the new attorneys of record for the representation of the application.

Notice of Co-pending applications

Also submitted herewith is a Letter of Co-pending application, which advises the Examiner of co-pending application No. 10/622,377, which the Examiner may wish to consider.


In view of the above amendments and Remarks, Applicant believes the pending application is in condition for allowance.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact MaryAnne Armstrong, PhD Reg. No. 40,069 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

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Respectfully submitted,

By: 

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